

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer Number: 46320
Yoshiko MIKAMI : Confirmation Number: 1909
Application No.: 10/632,160 : Group Art Unit: 2452
Filed: July 31, 2003 : Examiner: B. Whipple
Appeal No. 2009-006640 :
:

For: NETWORK SYSTEM ALLOWING THE SHARING OF USER PROFILE
INFORMATION AMONG NETWORK USERS

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Request for Rehearing is submitted under 37 C.F.R. § 41.52 in response to the Decision on Appeal dated September 28, 2010 (hereinafter the Decision). This Request for Rehearing is timely filed within the two month time period for reply set forth under 37 C.F.R. § 41.52(a)(1).

Appellant respectfully submits that in the Decision, the Honorable Board either misapprehended and/or overlooked certain arguments presented by Appellant in the Second Appeal Brief of June 17, 2008, and in the Reply Brief of October 20, 2008. Appellant will specifically identify these particular points below.

REMARKS

Decisions of the PTO tribunals are reviewed in accordance with the standards of the Administrative Procedure Act. See Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (applying the Administrative Procedure Act, 5 U.S.C. § 706, to appeals of PTO rulings). Thus, the Board's factual findings are reviewed to determine whether they are unsupported by substantial evidence, and the Board's legal conclusions are reviewed for correctness in law. See In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000). Substantial evidence means "more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Richardson v. Perales, 402 U.S. 389, 401 (1971).

On February 26, 2010, the precedential opinion of Ex parte Frye, Appeal 2009-006013, was issued by the Board of Patent Appeals and Interferences (BPAI). Referring to the first full paragraph on page 15 of Ex parte Frye, the following was stated:

Our decision is limited to the finding before us for review. The Board does not "allow" claims of an application and cannot direct an examiner to pass an application to issuance. Rather, the Board's primary role is to review adverse decisions of examiners including the findings and conclusions made by the examiner. See 37 C.F.R. § 41.50(a)(1) ("The Board, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner"). [footnote 2 omitted] (underline added)

The Honorable Board further went on to state within *Ex parte Frye* that:

The panel then reviews the obviousness rejection for error based upon the issues identified by appellant, and in light of the arguments and evidence produced thereon. *See Oetiker*, 977 F.2d at 1445 (“In reviewing the examiner’s

1 decision on appeal, the Board must necessarily weigh all of the evidence and
2 argument.”) (emphasis added); *see also* 37 C.F.R. § 41.37(c)(1)(vii) (appeal brief
3 must include “the contentions of appellant with respect to each ground of
4 rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis
5 therefor, with citations of the statutes, regulations, authorities, and parts of the
6 record relied on”). Specifically, the Board reviews the particular finding(s)
7 contested by an appellant anew in light of all the evidence and argument on that
8 issue. (emphasis added)

9

10 As discussed above, Appellant identifies the issues to be reviewed, and the decision of
11 the BPAI is limited to the findings and conclusions made by the Examiner.¹ Additionally, a
12 complete *de novo* review is to be performed on all issues that are raised by Appellant without
13 deference to the positions taken by the Examiner.

14

15 Referring to page 3 of the Decision, upon Appellant's arguments in the Second Appeal
16 Brief and the Reply Brief, the Honorable Board determined that two issues were raised: (i)
17 whether the Examiner presented a properly supported obviousness analysis and (ii) whether Gatz
18 or Walker taught “a list of one or more applications that the first user is permitted to execute.”

19

20 Issue 1

21 Referring to the first full paragraph on page 5 of the Decision, the Honorable Board
22 asserted:

23 Appellant argues that the Examiner provides insufficient rationale for
24 finding that it would have been obvious to an artisan to combine the teachings and

¹ Although the Honorable Board can employ findings and/or analysis not of record, doing requires the designation of a new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). *See, e.g., In re Kumar*, 418 F.3d 1361, 1365. (Fed. Cir. 2005); *In re DeBlauwe*, 736 F.2d 699, 706 n.9 (Fed. Cir. 1984).

1 suggestions of Gatz and Walker. Based on Appellant's arguments in the Appeal
2 Brief, we will decide the appeal with respect to issue 1 on the basis of claim 1.
3 *See 37 C.F.R. § 41.37(c)(1)(vii).*

4
5 At the outset, Appellant notes that the Honorable Board's characterization of Appellant's
6 arguments over-generalizes the specific arguments presented by Appellant. Appellant's specific
7 arguments and the Honorable Board's overlooking of the same will be subsequently addressed.
8 Appellant, however, will first focus on the Honorable Board's analysis on page 5 of the Decision.
9

10
11 Referring to the second full paragraph on page 5 of the Decision, the Honorable Board
12 asserted:

13 The teachings and suggestions of Gatz and Walker are both related. Gatz
14 relates to an access server the controls use of services based on children accounts
15 that are associated with parent accounts (FF 1). Walker relates to a browser
16 capable of accessing only web pages previously authorized by a parent of a user
17 of the browser (FF 3). Because the two references are related, the teachings and
18 suggestions of Walker would have been familiar elements to an artisan seeking to
19 modify Gatz, and vice versa.

20
21 Appellant respectfully submits that the Honorable Board's analysis is directed to whether or not
22 Gatz and Walker are both within the same field of endeavor. However, Appellant did not raise
23 the issue of Gatz and Walker not being within the same field of endeavor in either the Second
24 Appeal Brief or the Reply Brief. Merely alleging that certain references are within the same
25 field of endeavor does not meet the burden of articulating a reasoning based upon some rationale
26 underpinning to support a conclusion of obviousness. Thus, although the Honorable Board's

1 findings would have been relevant had Appellant raised the issue of the Examiner applying
2 nonanalogous prior art against the claims, these findings are not germane to the issues raised by
3 Appellant.

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6 Referring to the third full paragraph on page 5 of the Decision, the Honorable Board
7 asserted:

8 Appellant does not show that the Examiner's proposed combination of the
9 familiar elements of Gatz and Walker would have done anything more than yield
10 predictable results. Therefore, we find no error in the Examiner's finding that it
11 would have been obvious to an artisan to combine the teachings and suggestions
12 of Gatz and Walker. (emphasis added)

13

14 The Honorable Board's analysis raises five issues: (i) the Honorable Board has improperly
15 shifted the burden of proof; (ii) the Honorable Board places a requirement upon the claimed
16 invention that is not supported by the law; (iii) the Honorable Board raises a new grounds of
17 rejection; (iv) the Honorable Board's new grounds is factually unsupported; and (v) the
18 Honorable Board did not consider Appellant's arguments.

19

20

21 Improper burden shifting

22 By requiring that Appellant making a showing, the Honorable Board has improperly
23 shifted the burden of proof. "In rejecting claims under 35 U.S.C. § 103, the examiner bears the
24 initial burden of presenting a *prima facie* case of obviousness." In re Rijckaert, 9 F.3d 1531,
25 1532 (Fed. Cir. 1993) (citing In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992)). As noted

1 above, the Honorable Board is to perform a complete *de novo* review of all issues that are raised
2 by Appellant without deference to the positions taken by the Examiner. As stated in M.P.E.P. §
3 2142, "[i]f the examiner does not produce a *prima facie* case, the applicant is under no obligation
4 to submit evidence of nonobviousness." However, the Honorable Board has given deference to
5 the Examiner's position by improperly presuming that a *prima facie* case of obviousness has been
6 made and requiring that Appellant submit evidence of nonobviousness (i.e., "Appellant does not
7 show ..."). This improper burden shifting constitutes reversible legal error.

8

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10 **Improper requirement**

11 Appellant also notes that Honorable Board's assertion regarding Appellant failing to
12 establish that the combination of the applied prior art "would have done anything more than yield
13 predictable results." There is no requirement that Appellant's claimed invention produce
14 unpredictable results. See Bilski v. Kappos, 561 U.S. __ (2010) (Courts "should not read into the
15 patent laws limitations and conditions which the legislature has not expressed," citing Diamond
16 v. Diehr, 450 U. S. 175, 182 (1980)). As reproduced by the Honorable Board in the paragraph
17 pages 4 and 5 of the Decision, the Supreme Court has stated that a "combination of familiar
18 elements according to known methods is likely to be obvious when it does no more than yield
19 predictable results" (emphasis added). KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 416 (2007).
20 Notably, the Supreme Court did not state that a combination is '*necessarily* obvious' based a
21 finding that the combination does not more than yield predictable results.

22

1 Thus, even if the Examiner did make a finding, supported by substantial evidence, that
2 the proposed combination would do no more than yield predictable results, such a finding does
3 not lead, *per se*, to a conclusion of obviousness. Therefore, Appellant is not required to establish
4 that "the Examiner's proposed combination of the familiar elements of Gatz and Walker would
5 have done anything more than yield predictable results" in order to establish that the claimed
6 invention is not obvious. In short, the Honorable Board has an improperly imposed a
7 requirement for establishing non-obviousness that is not supported by either statute or case law.

8

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10 **New grounds**

11 The concept of "predictable results" refers to one or more of "Rationales To Support
12 Rejections Under 35 U.S.C. 103" discussed in Section III of the "Examination Guidelines for
13 Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR
14 International Co. v. Teleflex Inc.," 72 Fed. Reg. 57,526 (2007) (hereinafter the Examination
15 Guidelines for Determining Obviousness). Referring to the first column on page 57,529 of the
16 Examination Guidelines for Determining Obviousness, the following is a list of rationales that
17 may be used to support a finding of obviousness under 35 U.S.C. § 103:

18 (A) Combining prior art elements according to known methods to yield
19 predictable results;

20 (B) Simple substitution of one known element for another to obtain
21 predictable results;

22 (C) Use of known technique to improve similar devices (methods, or
23 products) in the same way;

24 (D) Applying a known technique to a known device (method, or product)
25 ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. (emphasis added)

The Examiner's analysis within the appealed Third Office Action or in the Examiner's
er, however, did not refer to "predictable results." To be clear, the Examiner's stated
le for combining Gatz and Walker in the appealed Third Office Action is found in the first
paragraph on page 5 and is reproduced below:²

It would have been obvious to one of ordinary skill in the art to modify the teachings of Gatz by permitting a first user to execute the programs being controlled by the first user for the second user as taught by Walker in order to allow a user to access desired programs.

The Examiner also did not refer to "predictable results" in any other portion of the Third Office Action or the Examiner's Answer.

To the extent that the Honorable Board, in affirming the Examiner's rejection, is relying upon one of the above-identified Rationales from the Examination Guidelines for Determining Obviousness that involve a finding of "predictable results," such a reliance constitutes a new grounds of rejection. Referring to *In re DeBlauwe*, *supra*, the Federal Circuit stated "[w]here the

² The same rationale is presented by the Examiner in the last full paragraph on page 5 of the Examiner's Answer.

1 board makes a decision advancing a position or rationale new to the proceedings, an applicant
2 must be afforded an opportunity to respond to that position or rationale by submission of
3 contradicting evidence").

4

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6 Factually unsupported new grounds

7 Each of Rationale (A), (B), and (D), which involve "predictable results," require different
8 findings of fact. These additional findings of fact, however, have not been articulated by either
9 the Examiner or the Honorable Board. Referring to Rationale (A), entitled "Combining Prior Art
10 Elements According to Known Methods to Yield Predictable Results," the Examination Guidelines
11 for Determining Obviousness states that the following findings of fact must be articulated by the
12 Examiner:

13 (1) a finding that the prior art included each element claimed, although not
14 necessarily in a single prior art reference, with the only difference between the
15 claimed invention and the prior art being the lack of actual combination of the
16 elements in a single prior art reference;

17 (2) a finding that one of ordinary skill in the art could have combined the
18 elements as claimed by known methods, and that in combination, each element
19 merely would have performed the same function as it did separately;

20 (3) a finding that one of ordinary skill in the art would have recognized
21 that the results of the combination were predictable; and

22 (4) whatever additional findings based on the Graham factual inquiries
23 may be necessary, in view of the facts of the case under consideration, to explain
24 a conclusion of obviousness.

25

1 Referring to Rationale (B), as discussed on page 57,530 of the Examination Guidelines for

2 Determining Obviousness, the following findings of fact must be articulated by the Examiner:

3 (1) a finding that the prior art contained a device (method, product, etc.)
4 which differed from the claimed device by the substitution of some components
5 (step, element, etc.) with other components;

6 (2) a finding that the substituted components and their functions were
7 known in the art;

8 (3) a finding that one of ordinary skill in the art could have substituted one
9 known element for another, and the results of the substitution would have been
10 predictable; and

11 (4) whatever additional findings based on the *Graham* factual inquiries may be
12 necessary, in view of the facts of the case under consideration, to explain a conclusion of
13 obviousness.

15 Referring to Rationale (D), as discussed on page 57,531 of the Examination Guidelines for

16 Determining Obviousness, the following findings of fact must be articulated by the Examiner:

17 (1) a finding that the prior art contained a "base" device (method, or
18 product) upon which the claimed invention can be seen as an "improvement;"

19 (2) a finding that the prior art contained a known technique that is
20 applicable to the base device (method, or product);

21 (3) a finding that one of ordinary skill in the art would have recognized
22 that applying the known technique would have yielded predictable results and
23 resulted in an improved system; and

24 (4) whatever additional findings based on the *Graham* factual inquiries
25 may be necessary, in view of the facts of the case under consideration, to explain
26 a conclusion of obviousness.

1 Not only has the Honorable Board not identified the alleged "predictable results," the
2 Honorable Board has not presented any additional findings of facts³ that are required in order to
3 employ these Rationales. By failing to present these additional findings of fact to support the
4 Honorable Board's new obviousness rationale, the Honorable Board's has failed to establish the
5 necessary factual support for the Honorable Board's new grounds of rejection.

6

7

8 Overlooking Appellant's arguments

9 Referring to the paragraph spanning pages 7 and 8 of the Second Appeal Brief, Appellant
10 noted that "allowing a user to access desired programs" is achieved through the use of either
11 Walker alone or Gatz alone. Thus, Walker *alone* allows a user to access desired programs and
12 Gatz *alone* allows a user to access desired programs. As reproduced above, the Examiner's
13 alleged rationale for combining Gatz and Walker is "to allow a user to access desired programs."
14 Appellant's position, citing to Ex parte Rinkevich, is, that as a matter of common sense, one
15 skilled in the art would not find a particular combination to be obvious when the proposed
16 benefit (e.g., the solving of a problem) of the combination has already achieved by the primary
17 reference. Put differently, once one skilled in the art achieves a particular desired result (i.e.,
18 benefit), one skilled in the art stops.⁴

19

³ With the exception of finding of fact (4) for each rationale because finding of fact (4) relates to the Graham factual inquiries, which the Examiner did perform.

⁴ Appellant recognizes that one skilled in the art could be motivated to continue to modify *if* the proposed combination achieves the same result but does so in an improved manner (e.g., more efficiently, more cost-effectively, etc.). However, the Examiner did not present any findings of fact that the proposed combination achieves the same result (i.e., "to allow a user to access desired programs") but in an improved manner. Thus, Appellant did not address this issue since it was not raised by the Examiner.

1 Referring to the first full paragraph on page 8 of the Second Appeal Brief, Appellant
2 argued that even if the findings of facing made by the Examiner were properly supported, the
3 systems of Walker and Gatz, either alone or in combination, do not require or involve the use of
4 the claimed "list of one or more applications that the first user is permitted to execute." Thus,
5 even if Walker and Gatz were combined, the proposed combination would still fail to render
6 obvious all of the claimed limitations. These points were expounded upon on pages 7 and 8 of
7 the Reply Brief.

8

9 The Honorable Board's analysis in the Decision does not indicate whether or not these
10 arguments were considered. Moreover, even if these arguments were considered, the Honorable
11 Board does give any indication why the Honorable Board did not consider these arguments to be
12 persuasive. Appellant, therefore, respectfully submits that the Honorable Board has overlooked
13 certain of Appellant's arguments.

14

15

16 Issue 2

17 Referring to the first full paragraph on page 6 of the Decision, the Honorable Board
18 characterized Issue 2 as "Appellant argues that neither Walker nor Gatz teach a list of one or
19 more applications that the parent is permitted to execute." To be clear, the claimed "a list of one
20 or more applications that the first user is permitted to execute" is not claimed in isolation. This
21 list is included within a request from a first user. Moreover, this list is stored in the profile of the
22 second user in response to the request. Additionally, this list is used to determine what
23 applications the second user is permitted to execute.

1

2

3 Overlooking Appellant's arguments

4 To be clear, the findings of fact⁵ made by the Examiner in the paragraph spanning pages

5 3 and 4 of the appealed Third Office Action is that Gatz teaches:

6 in response to a request from the first user identifying a list of one or more
7 applications that the first user is permitted to execute, storing the list in the profile
8 of the second user, whereby the second user is permitted to execute the
9 applications in the list under control of the first user ([0014], ln. 1-4; [0049], ln.
10 14-17; [0071]; [0073]; [0074], ln. 8-12; [0075]; a parent has control, through an
11 account based access control system, of access to an information network and
12 may allow no, limited, or full access by a child to applications such as email,
13 chatrooms, message boards, and online shopping; the parent identifies a list of
14 applications that the child is allowed to access, and the parent is allowed to access
15 due to full access rights, under the control of the parent).

16

17 Therefore, the findings of fact underlying the Examiner's analysis is that Gatz teaches the
18 claimed "in response to a request from the first user identifying a list of one or more applications
19 that the first user is permitted to execute, storing the list in the profile of the second user." These
20 findings of fact were challenged by Appellant on page 5 of the Appeal Brief. Therefore, as noted
21 above, the Honorable Board is to perform a complete *de novo* review on this issue raised by
22 Appellant without deference to the positions taken by the Examiner. Additionally, these factual
23 findings by the Examiner are to be reviewed to determine whether they are unsupported by
24 substantial evidence. The Honorable Board, however, has overlooked these arguments and

⁵ The same findings of fact are made by the Examiner in the last full paragraph on page 4 of the Examiner's Answer.

1 failed to determine whether or not the Examiner's findings of fact are unsupported by substantial
2 evidence.

3

4 The findings of fact explicitly presented by the Examiner in both the appealed Third
5 Office Action and the Examiner's Answer is that that Gatz teaches these limitations. The
6 Honorable Board's analysis, however, relies upon the combination of Gatz and Walker as to the
7 limitations at issue. Therefore, the Honorable Board has overlooked the issues raised by
8 Appellant in the Second Appeal Brief and deviated from the findings made by the Examiner.⁶
9 Moreover, by relying upon the combination of Gatz and Walker, the Honorable Board has
10 presented a new grounds of rejection.

11

12

13 No findings of fact as to the claimed "list of one or more applications that the first user is
14 permitted to execute"

15 Referring to the second full paragraph on page 6 of the Decision, the Honorable Board
16 asserted the following:

17 Appellant argues that "Gatz does not explicitly teach the claimed list of
18 one or more application[s] that the first user is permitted to execute" (App. Br. 5).
19 However, Appellant later admits that "the parent (supervisor, etc.) [in either
20 Walker or Gatz] appears to have access to the application by default" (App. Br.
21 8). Based on this admission, Walker and Gatz at least suggest one or more
22 applications that a first user is permitted to execute (i.e., that they have access by
23 default). Gatz discloses that a controlling parent can override restrictions on a

⁶ As will be subsequently discussed, this deviation from the Examiner's analysis constitutes a new grounds of rejection.

1 child account's ability to use services, such as participating in auctions or
2 accessing areas deemed inappropriate (FF 2).

3

4 Referring to the first underlined portion of the above-reproduced passage, Appellant does
5 not take issue with the Honorable Board's assertion that Walker and Gatz at least inherently teach
6 that a first user (e.g., a parent) is permitted to execute one or more applications. Notably,
7 although Walker and Gatz may teach that a first user is permitted to execute one or more
8 applications, this is not the same as a finding that Walker and/or Gatz teaches "a list of one or
9 more applications that the first user is permitted to execute" and that this list is included within a
10 request from a first user.

11

12 Referring the second underlined portion of the above-reproduced passage, the Honorable
13 Board's assertion that "Gatz discloses that a controlling parent can override restrictions on a child
14 account's ability to use services, such as participating in auctions or accessing areas deemed
15 inappropriate" does not refer, in any respect, to the claimed list or that the list is included within
16 a request from a first user.

17

18

19 Overlooking Appellant's arguments

20 Referring again to the second full paragraph on page 6 of the Decision, the Honorable
21 Board concluded the following:

22 Therefore, Gatz and Walker would have taught or suggested identifying
23 (overriding) a list of one or more applications (restrictions on services) that a first
24 user (a parent) is permitted to execute (can access by default) and a second user
25 (where the overriding is for a child account) that is permitted to execute the

1 applications (enabling the child account to access restricted services) in the list
2 under control of the first user (as permitted by the controlling parent).

3

4 The Honorable Board appears to be asserting that the claimed "identifying a list of one or
5 more applications that the first user is permitted to execute" is disclosed by "overriding ...
6 restrictions on services [that] a parent ... can access by default ... where the overriding is for a
7 child account." However, the Honorable Board assumes, without any factual basis, that the
8 claimed "list of one or more applications that a first user is permitted to execute" is needed for a
9 parent to modify a child account. There is simply no basis for this finding.

10

11 As argued by Appellant on page 7, lines 9-13 of the Reply Brief:

12 First, to permit (or deny) the execution of an application by a second user (i.e.,
13 allegedly disclosed by a child) does not require any knowledge of what
14 applications the first user is permitted to execute. Both Gatz and Walker are
15 capable of restricting access, by a child/employee, to applications without
16 knowing (or caring) what applications the parents/supervisor are capable of
17 accessing.

18

19 As further argued on page 7, lines 15-16, of the Reply Brief:

20 Second, neither Gatz nor Walker describe a need for a list of applications
21 that the parents/supervisor are capable of accessing.

22

23 Without an explicit teaching of "a list of one or more applications that the first user is
24 permitted to execute" or an established need for the "list of one more applications that the first
25 user is permitted to execute," it would not have been obvious to arrive at these limitations based
26 upon the teachings of Gatz and Walker, either alone or in combination.

1
2 The alleged fact that Gatz and Walker teach that a first user (i.e., a parent/supervisor) can
3 access a particular application by default does not necessarily require (i.e., inherently disclose)
4 that a list exists for applications that the first user is permitted to execute, as argued on page 8,
5 lines 2-9 of the Reply Brief.

6
7 Appellant refers back to the Honorable Board's new grounds of rejection regarding Issue
8 1 on page 5 of the Decision with regard to "the Examiner's proposed combination of the familiar
9 elements." There has been, however, no findings of fact, supported by substantial evidence, that
10 the claimed "list of one or more applications that the [patent/supervisor] is permitted to execute"
11 is a familiar element. Instead, Appellant's position has been that these limitations are (i) not
12 disclosed by either Gatz or Walker (i.e., it is not a familiar element), and (ii) the Examiner has
13 failed to establish that the teachings of Gatz and Walker require such an element in order to
14 perform their respective functions. Since there is no established need for the claimed list, Gatz
15 and Walker (either alone or in combination) also fail to teach receiving a request from the user
16 identifying the list or that the list is stored in the profile of the second user based upon the
17 request.

18
19

20 Referring to the paragraph spanning pages 6 and 7 of the Decision, the Honorable Board
21 asserted the following:

22 Appellant offers that "even if the parent inherently had access to the
23 applications, the parent . . . may not be permitted to use the application (e.g., the
24 parent chooses not to have access to the application or the parent is required to

1 sign up for [the] application, in order to use[] the application, and the parent has
2 not" (App. Br. 6-7). This attempt to distinguish between having access to an
3 application and having permission to execute an application is unpersuasive. The
4 claim language does not limit the list of applications to only include applications
5 that the first user is permitted to execute without any additional steps. Additional
6 steps, such as choosing to have access to or signing up to use, are not precluded
7 by the claim limitations.

8
9 Although directed to a minor point raised by Appellant, the Honorable Board has
10 misapprehended the issues raised by Appellant.

11
12 The issue raised by Appellant regarded the Examiner's assertion that "the parent, as the
13 controlling member of the online account, inherently has access to the applications being limited
14 for other users as the parent could not grant full access to other users if the parent did not have
15 full access" (emphasis added, see paragraph spanning pages 5 and 6 of the Second Appeal Brief).
16 Appellant's position is that there is no technical requirement that access, by a parent, to a
17 particular application is required in order for the parent to restrict access, by a child, to that
18 particular application.

19
20 The issue raised by Appellant regards the Examiner's factually-unsupported inherency
21 argument – not an "attempt to distinguish between having access to an application and having
22 permission to execute an application." The Honorable Board's characterization of Appellant's
23 arguments as an "attempt to distinguish between having access to an application and having
24 permission to execute an application" does not accurately characterize the points made by
25 Appellant. Using the Honorable Board's language, what Appellant actually argued is that

1 "having access to an application [by a parent is not needed for granting] permission [to a child]
2 to execute [the] application."

3

4

5 Besides the new grounds of rejections presented by the Honorable Board and the factual
6 deficiencies of these new grounds of rejections, the major points raised by Appellant during
7 appeal (and either overlooked or misapprehended by the Honorable Board) are as follows:

8 1) the Examiner's explicit finding of fact that Gatz teaches the
9 claimed "in response to a request from the first user identifying a list of one or
10 more applications that the first user is permitted to execute, storing the list in the
11 profile of the second user" is unsupported by substantial evidence;

12 2) Walker also fails to teach these limitations at issue;

13 3) both Gatz and Walker do not require "a list of one or more
14 applications that the first user is permitted to execute" in order to restrict a second
15 party's access to applications;

16 4) the Examiner's obviousness analysis fails to present any rational
17 supported by a rational underpinning to include "a list of one or more applications
18 that the first user is permitted to execute" when these limitations are (i) neither
19 disclosed by Gatz nor Walker; and (ii) not needed in order for Gatz or Walker to
20 perform their respective functions; and

21 5) the Examiner's obviousness analysis of record does not even lead
22 one skilled in the art to modify Gatz in view of Walker.

23

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: November 29, 2010

Respectfully submitted,

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